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10/533,356

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EXAMINER

IGYARTO, CAROLYN

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/533,356 | Applicant(s) LAMBERT ET AL. | |
| | Examiner CAROLYN IGYARTO | Art Unit 2884 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 6-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement submitted on 29 April 2005 has been considered by the Examiner and made of record in the application file.

Response to Amendment

3. The preliminary amendment filed on 29 April 2005 was accepted and entered.

Claim Objections

4. The claims are replete with errors. The claims should be revised carefully to correct the numerous errors. Examples of some of the errors are:

Claim 1, line 14 recites "allocated to the other markers"; instead "allocated to the other **objects or substances**" (emphasis added). Appropriate correction is required.

Claim 1, lines 15-16 recites "said object or said substance", however, previously "objects" and "substances" are recited (emphasis added). It seems that a possible change to help purposes of clarity would be "each of the objects or substances."

Claim 1, lines 17-18 recites "the allocated combination"; instead "the allocated combination of markers" should be recited.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 8 recites fenestration in relation to the wavelength ranges indicated in the authentication data stored in memory and extracted by identifying the bar code, so as to determine a readout code with said above parameters. However, this is a misuse of fenestration and makes this unclear and makes it so one of ordinary skill would not be enabled to make or use the invention because one of ordinary skill would not know how to interpret fenestration in this context.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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9. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). It is unclear what the term “fenestration” in claim 8 is suppose to mean, the accepted meanings are “1 : the arrangement, proportioning, and design of windows and doors in a building 2 : an opening in a surface (as a wall or membrane) 3 : the operation of cutting an opening in the bony labyrinth between the inner ear and tympanum to replace natural fenestrae that are not functional.” The term is indefinite because the specification does not clearly redefine the term.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claim rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kaish et al. (US 5,974,150), hereinafter referred to as Kaish.

13. With respect to **claim 1**, Kaish teaches a method for identifying and authenticating different objects or substances, this method using a computer system coupled to spectrophotometry means, said method comprising at least the two following successive phases :

- an initial phase comprising:
 - choosing a plurality of chemical markers which, when excited by an incident light ray, emit energy radiations whose frequency spectra can be distinguished from one another and with respect to objects and substances in which they are intended to be incorporated (col. 4, lines 18-23; col. 13, lines 61-65; col. 20, lines 19-36; col. 27, lines 22-23; claim 32),
 - allocating then incorporating in each of the objects or substances a combination of markers that is different to the combinations allocated to the other markers (col. 12, lines 12-15),

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- determining an authentication code for said object or said substance defined using parameters comprising at least the presence or absence of markers in the allocated combination (col. 17, lines 44-52),
- storing in the memory of a computer system the authentication code of all the objects or substances and of related data corresponding to these objects or these substances (col. 25, lines 5-6),
- allocating an identification code to the object or substance, such as a bar code or similar, this identification code possibly being associated with the object, with the substance, with its recipient, and/or its packaging (col. 17, lines 53-55),
- storing, in the memory of said system, the identification codes for each of the objects (col. 25, line 12),
- defining a correspondence between the identification codes and the authentication codes (col. 17, lines 50-53; col. 25, lines 10-16; col. 26, lines 39-40).
- an identification and authentication phase by said system, this phase comprising:
 - theoretical identification of the object or substance by reading the identification code associated with the object (col. 26, lines 36-40),
 - spectrophotometric analysis of at least part of the object or substance so as to detect said above parameters, in particular the presence or absence of

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markers, and determination of the authentication code of the object or substance (col. 13, lines 60-65; col. 14, line 66 - col. 15, line 1),

- authentication of the object if the theoretical identification code corresponds to the authentication code (col. 24, line 67 – col. 25, line 1),
- emission of a validation signal if a correspondence is detected or of an alert signal if the authentication code does not correspond to the identification code (col. 26, lines 10-15).

14. In the alternative if it is held that Kaish does not teach a combination of markers, which are allocated and incorporated in each object, to be different to combinations allocated to the other objects, then it is known in the marking art to mark different objects differently for the benefit of more clearly distinguishing between the different objects. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a combination of markers, which are allocated and incorporated in each object, as taught by Kaish, to be different to combinations allocated to the other objects, as is known in the art, for the benefit of more clearly distinguishing between the different objects.

15. Also, in the alternative if it is held that Kaish does not teach that spectrophotometric analysis is performed on at least part of the object to detect said parameters, then it is known in the detecting art to use spectrophotometric analysis when different objects or materials have different spectral characteristics for the benefit of quickly and easily distinguishing between different substances or objects. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention

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was made use spectrophotometric analysis, as is known in the art, on at least part of the object to detect said parameters, as is taught by Kaish, for the benefit of quickly and easily distinguishing between different substances or objects and as a person with ordinary skill has good reason to pursue the known options within his/her technical grasp.

16. With respect to **claim 9**, Kaish further teaches said marking is made via a medium containing the marker or markers, this medium possibly being a label or an insert (Abstract; col. 10, lines 57-60; col. 12, lines 18-20).

17. With respect to **claim 10**, Kaish further teaches said medium containing the marker or markers is reflective (Abstract).

18. With respect to **claim 13**, Kaish further teaches said combination of markers comprises at least one fluorescent marker (col. 12, lines 14-16).

19. Claim rejected under 35 U.S.C. 103(a) as being unpatentable over Kaish.

20. With respect to **claim 5**, Kaish, alone or in the alternative as modified above, teaches all of the limitations of claim 1, as explained above. Kaish does not explicitly teach the incorporation into the object and/or substance of one or more calibration markers by means of which the computer system conducts corrections and/or

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calibration so as to overcome noises possibly deriving from the composition of the substance or object, from variations in positioning such as the angle of incidence of the radiation emitted by the light ray generator, and distance to the object. However calibration marks, which are used to allow a processor to make corrections and calibrate the data being measured is known in the detector art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to try including the incorporation into the object and/or substance of one or more calibration markers by means of which the computer system conducts corrections and/or calibration so as to overcome noises possibly deriving from the composition of the substance or object, from variations in positioning such as the angle of incidence of the radiation emitted by the light ray generator, and distance to the object, as a person with ordinary skill has good reason to pursue the known options within his/her technical grasp.

21. With respect to **claim 11**, Kaish does not explicitly teach a blank medium free of any marker is added and also irradiated then, during data processing, the spectrum data of the blank medium are subtracted from the spectrum data of the marked medium so as to eliminate corresponding signals and to simplify analysis. However, it is known in the spectral art to use a standard or an area free of the object(s) or substance(s) being detected and subtracting the spectral data of the standard from the object(s) or substance(s) effected area for the benefit of removing the spectral features not related to the object(s) or substance(s) being detected and obtain a more accurate reading of

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the object(s) or substance(s). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a blank medium free of any marker is added and also irradiated then, during data processing, the spectrum data of the blank medium are subtracted from the spectrum data of the marked medium so as to eliminate corresponding signals and to simplify analysis for the benefit of removing the spectral features not related to the object(s) or substance(s) being detected and obtain a more accurate reading of the object(s) or substance(s) and as a person with ordinary skill has good reason to pursue the known options within his/her technical grasp.

22. With respect to **claim 12**, Kaish does not explicitly teach during data processing, the spectrum data of the object or substance free of markers are subtracted from the spectrum data of the marked object or substance. However, it is known in the spectral art to use a standard or an area free of the object(s) or substance(s) being detected and subtracting the spectral data of the standard from the object(s) or substance(s) effected area for the benefit of removing the spectral features not related to the object(s) or substance(s) being detected and obtain a more accurate reading of the object(s) or substance(s). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made during data processing, the spectrum data of the object or substance free of markers are subtracted from the spectrum data of the marked object or substance, for the benefit of removing the spectral features not related to the object(s) or substance(s) being detected and obtain a more accurate reading of

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the object(s) or substance(s) and as a person with ordinary skill has good reason to pursue the known options within his/her technical grasp.

23. Claim rejected under 35 U.S.C. 103(a) as being unpatentable over Kaish as applied to claim 1 above, and further in view of Shchegolikhin et al. (US 6,610,351), hereinafter referred to as Shchegolikhin.

24. With respect to **claim 2**, Kaish, alone or in the alternative as modified above, teaches all of the limitations of claim 1, as explained above. Kaish does not teach the specifics what steps make up the spectrophotometric analysis. Shchegolikhin, however, teaches that the following steps are a known way of obtaining spectral analysis

- irradiating the marked object or substance with a light ray emitted by a generator (block 3) (col. 1, lines 27-30),
- sending the transmitted or reflected waves onto a dispersing element which deflects them so as to obtain a light spectrum of the light intensity in different zones of the spectrum corresponding to different wavelength ranges (col. 1, lines 31-38),
- detecting the light intensity in said zone (col. 1, lines 29-31; col. 3, lines 9-13),
- comparing this intensity with one or more threshold values specifically allocated to this zone and which are recorded in memory as being said above parameters (col. 38-45; col. 3, lines 9-13),

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- the result of this comparison contributing towards determination of the authentication code of the object (col. 21-26 and 38-45).

25. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to try using the spectral analysis steps taught by Shchegolikhin, which are shown directly above, and as a person with ordinary skill has good reason to pursue the known options within his/her technical grasp.

26. With respect to **claims 6-7**, Kaish, as modified above, does not explicitly teach said above generator of light radiation comprises a light source with wide frequency spectrum such as an arc lamp or a light bulb generating a white light or said generator of light radiation comprises a plurality of laser radiation sources specifically chosen in relation to the type of chemical markers used, and a mixer to mix the different radiations emitted by these sources. However, these are known light sources in the detector art. It is also known in the art to select an appropriate light source for the materials your investigation, since it is known that different materials are better investigated with different sources. it would have been obvious to one of ordinary skill in the art at the time the invention was made to uses either comprises a light source with wide frequency spectrum such as an arc lamp or a light bulb generating a white light or said generator of light radiation comprises a plurality of laser radiation sources specifically chosen in relation to the type of chemical markers used, and a mixer to mix the different radiations emitted by these sources, based on what is going to be detected, since it has

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been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

27. Claim rejected under 35 U.S.C. 103(a) as being unpatentable over Kaish as applied to claims 1, 9, and 11 above, and further in view of Cremer et al (US 2005/0059681), hereinafter referred to as Cremer.

28. With respect to **claim 14**, Kaish, as modified above, teaches all of the limitations of claims 1, 9, and 11, as explained above. Kaish does not explicitly teach said parameters also comprise the duration of the light emission of the substance to be identified subsequent to excitation. However, Cremer teaches using fluorescence life time to identify characteristics of an object ([0206]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to try having said parameters also comprise the duration of the light emission of the substance to be identified subsequent to excitation, as taught by Cremer, as a person with ordinary skill has good reason to pursue the known options within his/her technical grasp.

29. With respect to **claim 15**, Kaish further teaches said parameters comprise: the presence or absence of fluorescence (col. 10, lines 22-26; col. 12, lines 11-15 and 52-55; col. 14, lines 5-10).

Allowable Subject Matter

30. Claims 3-4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

31. The following is a statement of reasons for the indication of allowable subject matter:

32. With respect to **claim 3**, Kaish further teaches that the identification code can carry a message about the certain characteristics (col. 22, lines 1-3 and 37-41; col. 24, line 65 – col. 25, lines 1). The prior art of record does not disclose or reasonably suggest, along with the other claimed limitations, a method for identifying and authenticating different objects or substances comprising: namely, the determination of said above zones of the spectrum to be analysed, and of the different parameters allocated to each of these zones, using said above identification codes.

33. With respect to **claim 4** the prior art of record does not disclose or reasonably suggest, along with the other claimed limitations, a method for identifying and authenticating different objects or substances comprising: namely, servo- controlling the light intensity emitted by the light radiation generator in relation to the difference between the value of the detected light intensity, over a predetermined frequency range not affected by the presence of the markers, and a predetermined set value.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CAROLYN IGYARTO whose telephone number is (571)270-1286. The examiner can normally be reached on Monday - Thursday, 7:30 A.M. to 5 P.M. E.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Porta can be reached on (571) 272-2444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CI
/David P. Porta/
Supervisory Patent Examiner, Art Unit 2884

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